



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,388	02/23/2004	Neil C. Leatherbury	PT-3000-US-NP	6576
68622	7590	09/16/2009		
NORMAN F. HAINER, JR. SMITH & NEPHEW, INC. 150 MINUTEMAN ROAD ANDOVER, MA 01801				
EXAMINER				
COMSTOCK, DAVID C				
ART UNIT		PAPER NUMBER		
3733				
MAIL DATE		DELIVERY MODE		
09/16/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/785,388

Applicant(s)

LEATHERBURY ET AL.

Examiner

DAVID COMSTOCK

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5, 8, 24-30 and 32-50 is/are pending in the application.
- 4a) Of the above claim(s) 24, 25, 39 and 40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 8, 26-30, 32-38 and 41-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-849)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 2009 has been entered.

Election/Restrictions

Applicant's election without traverse of Group I, claims 1-3, 5, 8, 26-30, 32-38 and 41-50, in the reply filed on 29 June 2009 is acknowledged. Claims 24, 25, 39 and 40 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5, 8, 26-27, 30, 32-38 and 41-50 are rejected under 35 U.S.C. 102(e) as being anticipated by DeMayo (US Patent Publication Number 2003/0065333).

DeMayo discloses a bone or cartilage implant delivery device comprising a tubular outer shaft, e.g. 11, having a proximal and distal end, a longitudinal axis, and an internal bore along the longitudinal axis of the outer shaft, wherein the distal end of the outer shaft is suitable for holding an implant, and an inner shaft, e.g. 12, having a distal end and a proximal end, wherein the proximal end of the inner shaft is suitable for insertion into a defect, wherein the entire inner shaft is adapted to fit within the internal bore of the outer shaft so that the inner shaft and the outer shaft are slidably engaged, wherein one or more of the shafts comprise means to provide friction-retarded movement of the inner shaft through the outer shaft, also comprising an implant disposed within the distal end of the outer shaft, also comprising at least one slot in the distal end of the outer shaft for visualizing the implant, wherein the proximal and distal ends of the inner and outer shafts have smooth, rounded surfaces (see figures 1-3). The distal ends of the shafts include smooth, rounded surfaces, e.g., as along their outer periphery.

With regard to the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over DeMayo, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over DeMayo (US Patent Publication Number 2003/0065333) in view of Spranza et al.(US Patent Number 6,302,887).

DeMayo discloses the claimed invention except the kit containing a knife. Spranza et al. disclose an implant delivery device (see figures 6 and 7) including a knife to cut the surrounding tissue (see column 6, lines 19-20). It would have been obvious to one skilled in the art at the time the invention was made to construct the kit of DeMayo with a knife, in view of Spranza et al. to cut surrounding tissue.

Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over DeMayo (US Patent Publication Number 2003/0065333), in view of Smith et al.(US Patent Number 5,697,932), cited by applicant.

DeMayo disclose the claimed invention except the kit containing a plurality of bone delivery devices. Smith et al. disclose a kit and the use of different sized instruments to accommodate surgical needs. It would have been obvious to one skilled in the art at the time the invention was made to construct the kit of DeMayo with a plurality of bone delivery devices, in view of Smith, to accommodate surgical needs.

Response to Arguments

Applicant's arguments filed 26 March 2009 have been fully considered but are not persuasive. It is noted that the inner shaft comprises a member 19 around a portion of an outer surface thereof, wherein the member has an internal ring shape and a surface that exerts at least some friction vis-à-vis other surfaces with which it comes in contact. It is further noted that since the bone graft material is an implant and it is housed within the inner shaft, which in turn is housed within the outer shaft, the implant is necessarily housed within the outer shaft as well.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Comstock whose telephone number is (571) 272-

4710 (a detailed message should be left if Examiner is unavailable). If attempts to reach the Examiner by telephone or voicemail are unsuccessful, the examiner's supervisor, Eduardo Robert, can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/David Comstock/

Examiner, Art Unit 3733

/Eduardo C. Robert/

Supervisory Patent Examiner, Art Unit 3733